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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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IM21/0422

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EXAMINER	
YEE, D	
ART UNIT	**PAPER NUMBER**
1742	

DATE MAILED: 04/22/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12 and 34-39, drawn to an article made from an alloy material, classified in class 420, subclass 585.

II. Claims 34-40, drawn to an article made from an alloy material and submerged in zinc/aluminum to form a surface coating, classified in class 428, subclass 653.

2. The inventions are distinct, each from the other because of the following reasons: Inventions of group II and group I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not depend for its patentability on the details of the subcombination. The subcombination has separate utility such as structural components in the form of bar or tube.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Charles Chandler on April 17, 1998 a provisional election was made with traverse to prosecute the invention of group I, claims 1-12

and 34-39. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12 and 34-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are indefinite because it has been held that claims drawn to an alloy without defining alloying ranges are merely functional, and are therefore indefinite since it defines a composition in terms of results to be produced rather than the actual quantities to be added. See Koebel v. Coe, 505OG513.

Claim 11 is indefinite because it recites " less than 50% iron" yet its parent claim 1 recites "a steel alloy material". For an alloy material to be considered steel, it must contain at least 50% iron.

Claim 36 is indefinite because there is no antecedent basis for "selected element".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Wilhelmsson.

The reference teaches an alloy material in claim 1 of column 9 which contains all the alloying constituents required by the recited claim. Although prior art does not teach an article intended to be submerged in molten zinc, molten aluminum and mixtures thereof as recited by the claims, such would not be a patentable distinction since it is merely applicant's future and intended use.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 2-12 and 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelmsson, Neuhausser et al, Culling, Crook et al, or Way et al.

Each reference teaches an alloy material with constituents whose wt% ranges overlap those recited by one or more of the recited claims; such overlap renders applicant's composition prima facie obvious despite differences in non-overlapping areas, see In re Malagari, 182 USPQ549.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is (703) 308-1102.

It should be noted that claim 39 submitted in paper no. 3 filed 2-1-98 has been renumbered to claim 40 because there is a claim 39 already in the specification on page 41

Specification

12. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

dy

April 20, 1998

Deborah Yee

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